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EXAMINER	
MOORTHY, ARAVIND K	

ART UNIT	PAPER NUMBER
2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,025	RISAN ET AL.	
	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the communications filed on 12 May 2008.

2. Claims 1-35 are pending in the application.

3. Claims 1-35 have been rejected.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 May 2008 has been entered.

Terminal Disclaimer

5. The terminal disclaimer filed on 6 May 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending Application No. 10/325243 and copending Application No. 10/364643 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

6. Regarding the rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention the Applicant's arguments with respect to claims 1, 2, 4-10, 13, 15, 16, 18-20, 22, 23, 25-31 and 34 have been considered but are moot in view of the new ground(s) of rejection.

7. Regarding the prior art rejection, Applicant's arguments filed 6 May 2008 have been fully considered but they are not persuasive.

On page 13, the applicant argues that the feature "controlling a data output path of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism" is not taught or render obvious over Doherty et al or Pastorelli et al and in fact would change the method of operation of both Doherty and Pastorelli.

The examiner respectfully disagrees. Pastorelli discloses that an execution request is intercepted before starting of the product. The examiner asserts that by intercepting the request, it is being diverted from a commonly used data pathway.

On page 15, the applicant agues that claim 15 is not render obvious by Doherty in view of Pastorelli. The applicant argues that the combination of Doherty and Pastorelli et al in view of Rhoads does not overcome the shortcomings of Doherty in view of Pastorelli.

The examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 4-10, 13, 15, 16, 18-20, 22, 23, 25-31 and 34 contain the trademark/trade name iTunes, iPod, Macintosh and Windows. However, the applicant has not specified which version of iTunes is being claimed. The applicant has not specified which model of iPod is being claimed. The applicant does not specify which version of the Macintosh and Windows operating system is being claimed. The examiner asserts that there were various versions of iTunes and Macintosh and Windows operating systems available at the time of filing of the current application. The examiner asserts that there were different models of the iPod available at the time of filing of the current application.

Any claims not directly addressed are rejected on the virtue of their dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-20 and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty et al U.S. Patent No. 6,920,567 B1 in view of Pastorelli et al US 2004/0133801 A1.

As to claim 1, Doherty et al discloses a method of preventing unauthorized recording of electronic media comprising:

> activating a compliance mechanism in response to receiving media content at a client system from a content provider providing content in a format compatible with an iTunes™ media service, the compliance mechanism coupled to the client system, the client system having a media content presentation application capable of handling the media content operable thereon and coupled to the compliance mechanism [column 4, lines 15-34];
>
> controlling a data output path carrying the media content of the client system with the compliance mechanism [column 4, lines 15-34]; and
>
> directing the media content to a custom media device coupled to the compliance mechanism via the data output path, for selectively restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al so that once an execution request of a product is made, it would be intercepted. Compliance of the execution request would have been verified. Starting of the product would have been enabled or prevented according to the result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

As to claims 2 and 23, Doherty et al teaches that the custom media device comprises an iTunes™ [Figure 1D].

As to claims 3 and 24, Doherty et al teaches the method further comprising:

restricting the client system to have the custom media device implemented as a default media device [column 7, lines 4-8].

As to claims 4 and 25, Doherty et al teaches the method further comprising:

interfacing with the iTunes™ media service through the media content presentation application that comprises an iTunes™ application [column 10 line 24 to column 11 line 20].

As to claims 5 and 26, Doherty et al teaches that the client system operates a Macintosh™ operating system [column 10 line 24 to column 11 line 20].

As to claims 6 and 27, Doherty et al teaches that the client system comprises an iPod™ [Figure 1D].

As to claims 7, 18 and 28, Doherty et al teaches the method further comprising:

> interfacing with the iTunes™ media service through the media content presentation application that comprises a Windows compatible iTunes™ application [column 10 line 24 to column 11 line 20].

As to claims 8 and 29, Doherty et al teaches that the client system operates a Windows™ operating system [column 10 line 24 to column 11 line 20].

As to claims 9, 19 and 30, Doherty et al teaches the method further comprising:

> preventing a recording application coupled to the client system from recording the media content when the recording the media content does not comply with at least one usage restriction applicable to the media content as applied by the iTunes™ media service [column 10, lines 10-23].

As to claims 10, 20 and 31, Doherty et al teaches the method further comprising:

> allowing a recording application coupled to the client system for recording the media content when the recording the media content complies with usage restrictions applicable to the media content as applied by the iTunes™ media service [column 10, lines 10-23].

As to claims 11 and 32, Doherty et al teaches the method further comprising:

> authorizing the client system to receive the media content [column 3, lines 17-19; column 5, lines 42-43; column 9, line 60].

As to claims 12 and 33, Doherty et al teaches the method further comprising:

> accessing an indicator associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content [column 8, lines 1-6].

As to claims 13 and 34, Doherty et al teaches the method further comprising:

> altering the compliance mechanism in response to a change in a usage restriction applicable to the media content as applied by the iTunes™ media service, wherein the usage restriction comprises a copyright restriction or licensing agreement applicable to the media content [column 12, lines 35-47].

As to claims 14 and 35, Doherty et al teaches that the media content is received from a source coupled to the client system, the source from the group consisting of: a network, an electronic media device, a media storage device, a media storage device inserted in a media device player, a media player application, and a media recorder application [column 5, lines 34-36; column 7, lines 63-66; Figure 1D].

As to claim 15, Doherty et al discloses a method of preventing unauthorized recording of electronic media comprising:

> activating a compliance mechanism in response to handling media content at a client system that is operating a Windows ™ operating system, wherein the content complies with a format compatible with a Windows™ compatible iTunes™ media service, the compliance mechanism coupled to the client system [column 4, lines 15-34];
>
> controlling a data output path carrying the media content of the client system with the compliance mechanism [column 4, lines 15-34]; and

directing the media content to a custom media device coupled to the compliance mechanism via the data output path, for selectively restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al so that once an execution request of a product is made, it would be intercepted. Compliance of the execution request would have been verified. Starting of the product would have been enabled or prevented according to the result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

As to claim 16, Doherty et al teaches the method further comprising:

receiving the media content from a content provider providing content in a format compatible with the iTunes™ media service [column 10 line 24 to column 11 line 20].

As to claim 17, Doherty et al teaches the method further comprising:

receiving the compliance mechanism in a package that contains the media content [column 10 line 24 to column 11 line 20]; and

installing the compliance mechanism on the client system [column 10 line 24 to column 11 line 20].

As to claim 22, Doherty et al discloses a computer system comprising:

a processor [column 10, lines 24-65]; and

a computer readable memory coupled to the processor and containing program instructions that, when executed, implement a method of preventing unauthorized recording of electronic media [column 10, lines 24-65] comprising:

activating a compliance mechanism in response to receiving media content at a client system from *a* content provider providing content in a format compatible with an iTunesTM media service, the compliance mechanism coupled to the client system, the client system having a media content presentation application capable of handling the media content operable thereon and coupled to the compliance mechanism [column 4, lines 15-34];

controlling a data output path carrying the media content of the computer system with the compliance mechanism [column 4, lines 15-34]; and

directing the media content to a custom media device coupled to the compliance mechanism via the data output path, for selectively restricting output of the media content [column 4, lines 15-34].

Doherty et al does not teach diverting a commonly used data pathway of the media content presentation application to a controlled data pathway monitored by the compliance mechanism.

Pastorelli et al teaches intercepting an execution request. Compliance of the execution request with authorized conditions is verified. Starting of the product is enabled or prevented according to the result of the verification [0045].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al so that once an execution request of a product is made, it would be intercepted. Compliance of the execution request would have been verified. Starting of the product would have been enabled or prevented according to the result of the verification.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Doherty et al by the teaching of Pastorelli et al because it allows programs running on the device to be controlled in real-time. In this way, a very effective licensing validation is carried out at low cost [0046].

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty et al U.S. Patent No. 6,920,567 B1 and Pastorelli et al US 2004/0133801 A1 as applied to claim 15 above, and further in view of Rhoads et al U.S. Patent No. 6,442,285 B2.

As to claim 21, the Doherty-Pastorelli combination does not teach accessing a watermark associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content.

Rhoads et al teaches accessing a watermark associated with the media content for indicating to the compliance mechanism that a usage restriction is applicable to the media content [column 10, lines 22-30].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Doherty-Pastorelli combination so that the media content would have been marked with a watermark to indicate to the compliance mechanism that a usage restriction is applicable to the media content.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Doherty-Pastorelli combination by the teaching of

Rhoads et al because the watermark can control different levels of use of the media (i.e. no playback, single playback, two playbacks etc.) [column 6, lines 19-54].

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aravind K Moorthy/
Examiner, Art Unit 2131
/Ayaz R. Sheikh/
Supervisory Patent Examiner, Art Unit 2131